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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/565,781

01/25/2006

Naoki Taki

07057.0116-00000

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22852

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03/16/2009

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

TRAN, DALENA

ART UNIT

PAPER NUMBER

3664

MAIL DATE

DELIVERY MODE

03/16/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/565,781	Applicant(s) TAKI, NAOKI	
	Examiner Dalena Tran	Art Unit 3664	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-46 and 50-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-46, 50-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10565781	1/25/06	TAKI, NAOKI	07057.0116-00000

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EXAMINER

Dalena Tran

ART UNIT	PAPER
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3664	20090314
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

DETAILED ACTION

Notice to Applicant(s)

1. This office action is responsive to the amendment filed on 12/16/08. As per request, claims 25, 40, 44, 50, and 55 have been amended. Claims 25-46, and 50-58 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 25-46, and 50-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per claims 25-46, and 50-58, the new added limitation “requests an ECU or the device that has the failure to provide details regarding the failure and proceeds to collect the details regarding the failure from the ECU of the device that has the failure” was not described in the specification. In the remarks page 17, last paragraph, of the amendment sent on 12/16/08 applicant said “this capacity of the ECU is disclosed in paragraph [0095] of the specification”. However, in reviewing the PG PUBS # 20060247832 (the current application), paragraph [0095], does not said anything about “requests an ECU or the device that has the failure to provide details regarding the failure and proceeds to collect the details regarding the failure from the ECU of the device that has the failure”,

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as the new current add limitation in the claims. Also, there are not any other place in the specification that described the new added limitations. Verification is required.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 44, is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 44, new claim element (the underlined), “means notifies the user of the countermeasures provided in the first countermeasure information and requests an ECU of the device that has the failure to provide details regarding the failure and the failure information means proceeds to collect the details regarding the failure detected by the failure detection means from the ECU of the device that has the failure for transmission in a second failure information”, is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. There are no disclose in the specification that described the new added limitations “requests an ECU of the device that has the failure to provide details regarding the failure and the failure information means proceeds to collect the details regarding the failure detected by the failure detection means from the ECU of the device that has the failure for transmission in a second failure information”.

Applicant is required to:

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(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 25-29, 34-36, 39-46, and 50-58, are rejected under 35 U.S.C.103(a) as being unpatentable over Saito et al. (US 2002/0044049 A1) in view of Chou et al. (6330499).

As per claim 25, Saito et al. disclose a vehicular diagnostic method, comprising: determining whether a failure has occurred in a device mounted in a vehicle; transmitting a first failure information that specifies the failure that is determined to have occurred, from the vehicle to a communications center (see the abstract; and [0063-0068]); receiving the first failure information at the communications center, whereupon a first countermeasure information, which provides countermeasures for the failure specified in the first failure information, is prepared; transmitting the first countermeasure information from the communications center to the vehicle (see [0009]; and [0069-0070]). Saito et al. do not disclose second failure information. However, Chou et al. disclose receiving the first countermeasure information at the vehicle, whereupon the vehicle notifies a user of the vehicle of the countermeasures provided in the first countermeasure information and requests an ECU of the device that has the failure to provide details regarding the failure and proceeds to collect the details regarding the failure from the ECU of the device that has the failure for transmission in a second failure information which specifies the collected details regarding the failure; transmitting the second failure information from the vehicle to the communications center (see column 4, lines 1-67; columns 6-7, lines 55-40; and column 8, lines 22-64); receiving the second failure information at the communications center, whereupon the collected details regarding the failure specified in the second failure information, are checked and a second countermeasure information, which provides detailed countermeasures for the

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failure, is prepared (see column 5, lines 1-12); transmitting the second countermeasure information from the communications center to the vehicle; and receiving the second countermeasure information at the vehicle, whereupon the vehicle notifies the user of the detailed countermeasures provided in the second countermeasure information (see column 5, lines 13-33; and column 6, lines 1-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teach of Saito et al. by combining second failure information for providing detail vehicle information for the purpose of diagnosing and maintenance vehicle system.

As per claim 26, Saito et al. disclose upon receiving the first failure information, the communications center transmits the first failure information to a computer provided at an automobile dealer that services the vehicle, which prepares the first countermeasure information in response to the first failure information and transmits the prepared first countermeasure information to the communications center (see [0010]). Saito et al. do not disclose second failure information. However, Chou et al. disclose upon receiving the second failure information, the communications center transmits the second failure information to the computer at the automobile dealer, which prepares the second countermeasure information in response to the second failure information and transmits the prepared second countermeasure information to the communications center (see column 5, lines 13-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teach of Saito et al. by combining second failure information for providing detail vehicle information for the purpose of diagnosing and maintenance vehicle system.

As per claim 27, Saito et al. disclose it is determined that a failure has occurred in the device mounted in the vehicle when an alarm lamp, which illuminates when an abnormality has occurred in the device mounted in the vehicle, illuminates; and the first failure information indicates that the alarm lamp has illuminated (see [0009]).

As per claim 28, Saito et al. disclose the collected details regarding the failure specified in the second failure information include at least one of sensor information from various sensors mounted in the vehicle, operation state information of the device mounted in the vehicle, and self-diagnosis information from the device mounted in the vehicle (see [0013]).

As per claim 29, Saito et al. do not disclose second failure information. However, Chou et al. disclose transmitting an information transmission request, which requests the vehicle to transmit the second failure information, from the communications center after the first failure information has been received; and receiving the information transmission request at the vehicle, whereupon the vehicle transmits the second failure information to the communications center (see column 4, lines 1-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teach of Saito et al. by combining second failure information for providing detail vehicle information for the purpose of diagnosing and maintenance vehicle system.

As per claim 34, Chou et al. also disclose the details regarding the failure to be collected for transmission in the second failure information are related only to the failure specified in the first failure information (see column 4, lines 1-67).

As per claims 35-36, Saito et al. disclose the vehicle transmits the first failure information at predetermined intervals of time, when transmitting the first failure information to the communications center two or more times, and the center receives the first failure information at predetermined intervals of time, when receiving the first failure information from the vehicle two or more times (see [0059-0062]).

As per claim 39, Saito et al. disclose storing at least the first failure information, from among the first failure information and second failure information, transmitted from the vehicle to the communications center; and providing at least the first failure information stored at the communications center to an external terminal device requesting at least the first failure information (see [0014-0018]; and [0051-0052]).

Claims 40, and 41, are system claims corresponding to method claims 25, and 39 above. Therefore, they are rejected for the same rationales set forth as above.

Claims 42-43, are system claims corresponding to method claims 27-28 above. Therefore, they are rejected for the same rationales set forth as above.

As per claim 44, Saito et al. disclose a vehicle, comprising: failure detection means for detecting the occurrence of a failure in a device mounted in the vehicle; failure information output means for means for outputting failure information specifying the failure detected by the failure detection means (see the abstract; and [0063-0068]); communication means for transmitting failure information, output from the failure information output means, to a device outside of the vehicle and for receiving countermeasure information from the device outside of the vehicle (see [0009]; and [0069-0070]); and failure notification means for notifying a user of the vehicle of

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countermeasures indicated in countermeasure information from the device outside of the vehicle ([0009]), wherein the failure information output means outputs a first failure information that specifies the failure detected by the failure detection means in the device mounted in the vehicle (the abstract; and [0063-0068]); the communication means transmits the first failure information to the device outside of the vehicle and receives a first countermeasure information from the device in response ([0009]; and [0069-0070]). Saito et al. do not disclose second failure information. However, Chou et al. disclose after receiving the first countermeasure information, the vehicle failure notification means notifies the user of the countermeasures provided in the first countermeasure information and requests an ECU of the device that has the failure to provide details regarding the failure and the failure information means proceeds to collect the details regarding the failure detected by the failure detection means from the ECU of the device that has the failure for transmission in a second failure information, the communication means transmits the second failure information to the device outside of the vehicle and receives a second countermeasure information from the device in response (see column 4, lines 1-67; columns 6-7, lines 55-40; and column 8, lines 22-64); and the failure notification means notifies the user of countermeasures indicated in the second countermeasure information (column 5, lines 13-33; and column 6, lines 1-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teach of Saito et al. by combining second failure information for providing detail vehicle information for the purpose of diagnosing and maintenance vehicle system.

Claims 45-46, are system claims corresponding to method claims 27-28 above. Therefore, they are rejected for the same rationales set forth as above.

Claims 50, and 55, are system claims corresponding to method claims 25 and 34 above. Therefore, they are rejected for the same rationales set forth as above.

Claims 51, and 60, are system claims corresponding to method claim 39 above. Therefore, they are rejected for the same rationales set forth as above.

Claims 52-54, and 56-58, are system claims corresponding to method claims 27-28 above. Therefore, they are rejected for the same rationales set forth as above.

6. Claims 30-33, and 37-38, are rejected under 35 U.S.C.103(a) as being unpatentable over Saito et al. (US 2002/0044049 A1), and Chou et al. (6330499) as applied to claim 25 above, and further in view of EP 0383593.

As per claims 30-31, Saito et al. do not disclose determining whether the vehicle is running or not running. However, EP 0383593 discloses determining whether the vehicle is running, wherein collection of at least the details regarding the failure for transmission in the second failure information is prohibited when it is determined that the vehicle is running, and collection of at least the details regarding the failure for transmission in the second failure information proceeds when it is determined that the vehicle is not running; the collection of at least the details regarding the failure for transmission in the second failure information, when it is determined that the vehicle is not running, proceeds when the user of the vehicle performs a predetermined operation (see column 2, line 29 to column 3, line 44; column 6, lines 6-25; column 8, line 46 to column 9, line 42; and column 14, lines 20-53). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teach of Saito et al. by combining determining whether the vehicle is running or not running for transmitting vehicle information corresponding to engine condition of the vehicle.

As per claims 32-33, EP 0383593 also discloses the predetermined operation performed by the user initiates the collection of the details regarding the failure for transmission in the second failure information, and the predetermined operation performed by the user is an operation of an operating means that includes a preset function to initiate the collection of the details regarding the failure for transmission in the second failure information (see column 5, lines 16-48).

As per claims 37-38, Saito et al. do not disclose transmits the second failure information at predetermined time intervals. However, EP 0383593 discloses the vehicle transmits the second failure information at predetermined intervals of time, when transmitting the second failure information to the communications center two or more times, and the center receives the second failure information at predetermined intervals of time when receiving the second failure information from the vehicle two or more times (see column 8, line 26 to column 9, line 42; and column 11, line 25 to column 12, line 21). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teach of Saito et al. by combining transmits the second failure information at predetermined time intervals for diagnosis vehicle condition.

Remarks

7. Applicant's argument filed on 12/16/08 has been fully considered. Upon updated search, the new ground of rejection as above, as the result of the new claims amended.
8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136 (a).

A shorten statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE MONTHS shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136 (a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dalena Tran whose telephone number is 571-272-6968. The examiner can normally be reached on M-W (in a first week of a bi-week), and T-R (in a second week of bi-week) from 7:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Khoi H. Tran can be reached on 571-272-6919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dalena Tran/

Primary Examiner, Art Unit 3664

March 14, 2009

